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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,664

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Akihiko Ikeya

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EXAMINER

PARVINI, PEGAH

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,664	<b>Applicant(s)</b> IKEYA ET AL.	
	<b>Examiner</b> PEGAH PARVINI	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

**Claims 4 and 5** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from a subsequent claim; claims 4 and 5 depends from “any one of claims 1 to 3 or 6”. See MPEP § 608.01(n). Accordingly, the claims 4 and 5 not been further treated on the merits.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of **claim 1** under 35 U.S.C. 103(a) as being unpatentable over Herget et al. in view of Berthiaume et al. as generally presented in the previous Office action is proper and stands.

With further reference to claim 1 and specifically to the new limitations directed to “for preparing a UV metallic composition” and “UV metallic composition is a UV metallic ink composition or a UV metallic coating material composition”, it is to be noted that considering the fact that UV metallic coating or UV metallic ink is within the broad group of coating or printing inks which are disclosed by the references specially Herget et al., the combination of references is seen to meet said limitations.

Nevertheless, it is to be noted that said limitations are directed to the intended use of a metallic pigment composition. With reference to intended use statements, the Applicants have not shown whether they somehow impart a structural difference between the claimed invention and the prior art. See MPEP § 2111.02. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Therefore, the combination of references, specially, the teachings of Herget et al. is seen to broadly read on the limitation of instant claim 1.

It is to be noted that claims 4 and 5 have not been further treated on the merits for the reason indicated above.

The rejection of **claim 2** under 35 U.S.C. 103(a) as being unpatentable over Herget et al. in view of Berthiaume et al. as applied to claim 1 above, and further in view of Kuwajima et al. as generally presented in the previous Office action is proper and stands.

The rejection of **claim 3** under 35 U.S.C. 103(a) as being unpatentable over Herget et al. in view of Berthiaume et al. as applied to claim 1 above, and further in view of Takahashi et al. and Itoh et al. as generally presented in the previous Office action is proper and stands.

**New claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Herget et al., Berthiaume et al., and Kuwajima et al. as applied to claim 2, and further in view of the combination of Takahashi et al. and Itoh et al.

The combination of Herget et al. and Berthiaume et al. disclose a composition comprising platelet-shaped metal oxide (which may be coated as disclosed in Herget et al., column 5, lines 20-22) and nitrocellulose having overlapping ranges of nitrogen content with the one instantly claimed; further, the degree of polymerization is obvious as detailed out in the previous Office action. Additionally, the combination of Herget et al., Berthiaume et al., and Kuwajima et al. teach the application of a coating of phosphorus compound onto flakes of metallic pigment motivated by the fact that the application and treatment of metallic pigment with phosphorus compound makes the metallic pigment to be stably dispersed in the pigment composition as that taught by Kuwajima et al.

However, the above combination does not expressly disclose dissolving nitrocellulose in 2-hydroxy-3-phenoxypropyl acrylate.

Nevertheless, it would have been obvious to one ordinary skill in the art to modify the combination of the references as set forth above in order to include 2-hydroxy-3-phenoxypropyl acrylate as a suitable diluent for dissolving nitrocellulose motivated by the fact that Takahashi et al., drawn to coating compositions, disclose that their coating composition comprises a component resulting from the reaction of a mercapto group-containing cellulose derivative such as nitrocellulose with one or more polymerizable monomers such as 2-hydroxyethyl acrylate (Abstract; column 13, lines 25-50). It is

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noted that although Takahashi et al. may not expressly and specifically disclose 2-hydroxy-3-phenoxypropyl acrylate, however, this compound would be an obvious variant to 2-hydroxyethyl acrylate as both are functionally equivalent as that disclosed by Itoh et al.; Itoh et al. disclose them to be reactive diluent in ink compositions (Abstract; [0043]). The combination of Takahashi et al. in view of Itoh et al. is, thus, to read on the limitation of claim 3 absent clear and specific evidence showing the contrary. It is to be noted that the substitution of one functionally equivalent material for another that is to be used for the same purpose (i.e. diluent) is well within the scope of the skilled artisan absent clear evidence otherwise.

### ***Response to Amendment***

The amendments made to claim 1, filed May 11, 2009, are acknowledged. However, said amendments do not place the application or the claims in condition for allowance as set forth above.

The amendments made to claims 4 and 5, filed May 11, 2009, are acknowledged. However, said claims as amended are not further treated on the merits as detailed above.

### ***Response to Arguments***

Applicants' arguments filed May 11, 2009 have been fully considered but they are not persuasive.

Applicants have argued that instant application is drawn to efficiently adsorbing nitrocellulose on the surface of the metal flakes which prevents the metal flakes from promoting initiation of polymerization.

The Examiner, respectfully, submits that this is not deemed persuasive since arguments cannot take the place of evidence in the record to overcome a rejection, and Applicants have not presented hard and tangible evidence proving that the composition of the references as combined does not impart the desired effect/property intended by Application specially since the combination of references discloses a very similar composition.

With reference to the nitrocellulose being adsorbed on the surface of the metal flakes, it is to be noted that the features upon which applicant relies (i.e., nitrocellulose being adsorbed on the surface of the metal flakes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, in response to applicant's arguments against the references individually, such as Herget and Berthiaume, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/  
Examiner, Art Unit 1793

/J.A. LORENZO/  
Supervisory Patent Examiner, Art  
Unit 1793